

Application/Control No.: 10/689,326
Response mailed December 4, 2006
Reply to Office Action of March 5, 2007

Amendments to the Drawings:

The attached sheet of drawings includes changes to Fig. 1. The sheet, which includes Fig. 1, replaces the original sheet including Fig. 1.

Attachment: Replacement Sheet for Fig. 1.

REMARKS

This paper is submitted in reply to the Office Action dated December 4, 2006 within the three-month period for response. Reconsideration and allowance of all pending claims are respectfully requested.

In the subject Office Action the drawings were objected to by the Examiner. In addition, claims 1-10, 12-16, and 18-20 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,344,566 (Miles et al.). Furthermore, claims 11 and 17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Miles et al. in view of U.S. Patent No. 4,461,128 (Knoeb).

Applicants respectfully traverse the Examiner's rejection to the extent that they are maintained. Applicants have amended claims 1 and 12, and added new claim 21. Applicants submit no new matter is being added by the above amendments, or new claim, as the amendments and new claim are fully supported in the specification, drawings and claims as originally filed.

Drawing Objections

Now turning to the subject office action specifically with regard to the drawing objections, the Examiner will note that Applicants have amended FIG. 1 to show reference number 30, which identifies the "plurality of gutter brackets or hangers." (Specification, p. 5, l. 14.) Applicants also note that bracket 30 is identified in originally files FIGS. 2 and 3. With regard to "roof 10," Applicants note this was identified in

originally filed FIG. 1. Accordingly, withdrawal of the objections to the drawings is respectfully requested.

Rejection of Claims Under 35 U.S.C. § 102(b)

It is well settled that “[a]nticipation under 35 U.S.C. § 102 means lack of novelty, and is a question of fact. To anticipate, every element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim.” *Brown v. 3M*, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001), *cert. denied*, 535 U.S. 970 (2002). Moreover, “[a] single reference must describe the claimed invention with sufficient precision and detail to establish that the subject matter existed in the prior art.” *Verve LLC v. Crane Cams Inc.*, 65 U.S.P.Q.2d 1051, 1054 (Fed. Cir. 2002). Finally, in addition to the requirement that the anticipating reference describe the patented subject material with sufficient clarity and detail to establish that the subject matter existed in the prior patent, it must also establish “that such existence would be recognized by persons of ordinary skill in the field of the invention.” *Crown Operations Int’l Ltd. v. Solutia Inc.*, 62 U.S.P.Q.2d 1917, 1921 (Fed. Cir. 2002).

The Office Action rejected claims 1-10, 12-16, and 18-20 under 35 U.S.C. §102(b) as being anticipated by Miles et al. Independent claim 1 is the base claim for dependent claims 2-10, independent claim 12 is the base claim for dependent claims 13-16, and independent claim 18 is the base claim for dependent claims 19-20. Independent claims 1, 12, and 18 recite “an eave beam supporting a plurality of rafters” or “a generally horizontal eaves beam.” However, Miles et al. never explicitly identifies

or discloses an eaves beam. The Office Action equates the "unlabelled board supporting rafter 8" with the recited "eaves beam." (Office Action at 3.) However, the structure that is directly below and touching the rafter 8 and which appears to extend into the interior of the structure, appears to be a board that is part of the roof or ceiling structure and not an eave beam. In other words, it does not generally run parallel to the eaves of building, but rather extends perpendicular to the eaves of the building.

Moreover, to the extent that the Office Action is referring to either of the structures directly below this horizontal structure, neither of which are identified or discussed in the Miles et al., Applicants note that there is no indication that these structures properly could be considered to be an eaves beam. They may more appropriately be considered to be caps or headers to the unidentified frame like structure or wooden stud directly below them. There is simply no disclosure that these items are relatively long structures that extend longitudinally along the eaves of a roof.

Accordingly, because Miles et al. does not disclose an eaves beam, it cannot anticipate claims 1-10, 12-16, or 18-20.

Independent claims 1, 12, and 18 also recite "a plurality of panels supported by said rafters" or "a plurality of sloped panels and a plurality of sloped rafters supporting said panels." However, Miles et al. never discloses any panels. Nor does the Office Action equate anything in Miles et al. with the recited plurality of panels. Accordingly, because Miles et al. does not disclose a plurality of panels, it cannot anticipate claims 1-10, 12-16, or 18-20.

Independent claims 1 and 12 and dependent claim 19 also originally recited “a mounting arm attached to said eave beam” and as now amended recite “a mounting arm supported by said eaves beam.” As discussed, Miles et al. does not disclose an eaves beam, and hence, also does not disclose an eaves beam which supports a mounting arm.

Moreover, the Office Action equates the bracket 98 of Miles et al. with the recited “mounting arm.” (Office Action at 3.) However, as is clear from Figs. 1 and 2 of Miles et al., this bracket 98 is not supported by anything that could reasonably be considered to be an eaves beam but rather “is secured to a wooden part of the structure by nails 100 driven through ears 102, 104 integral with one end of the body of the bracket.” (Miles et al., col. 3, ll. 52-54.) Accordingly, because Miles et al. does not disclose a mounting arm that is supported by an eaves beam, it cannot anticipate claims 1-10, 12-16, or 19-20.

Dependent claim 4 and independent claim 12 further recites a “mounting arm comprises an external trim plate with a horizontal ledge” or a “mounting arm having an external trim plate with a horizontal ledge.” The Office Action equates the mould bar receiver 74 of Miles et al. with the recited “external trim plate with a horizontal ledge.” (Office Action at 3.) However, the mould bar receiver 74 of Miles et al. is not part of the bracket 98, which again the Office Action equates with the recited “mounting arm.” *Id.* Additionally, as shown in Figs. 1 and 2 of Miles et al., the mould bar receiver 74 is not an exterior piece and certainly not an external trim plate.

With regard to the bracket 98, as also shown in Figs. 1 and 2 of Miles et al., bracket 98 is generally angular in orientation, not horizontal, and at the end distal from the building structure, contains "tabs 106, 108, 110." (Miles et al., col. 3, l. 55.) In other words, there is nothing in bracket 98 itself that can be equated with the recited "external trim plate" and certainly not one "with a horizontal ledge." Accordingly, because Miles et al. does not disclose a mounting arm with an external trim plate with a horizontal ledge, it cannot anticipate claims 4 or 12-16.

Turning to dependent claims 5 and 13, they recite that the "soffit is attached to said horizontal ledge." Again, the Office Action equates the mould bar receiver 74 of Miles et al. with the recited "horizontal ledge." (Office Action at 3.) However, as discussed and shown in Figs. 1 and 2 of Miles et al., the bracket 98, which the Office Action equates with the recited "mounting arm" does not have a horizontal ledge. Also, as shown in Fig. 2 of Miles et al., the leg 76 of the mould bar receiver 74 is angular in orientation and is positioned over the soffit member 2. There is no disclosure in Miles et al. of the soffit member 2 being attached to the mould bar receiver 74 or the leg 76 thereof or its astragal depression 75. Accordingly, because Miles et al. does not disclose a soffit that is attached to a horizontal ledge, it cannot anticipate dependent claims 5 or 13.

Dependent claim 6 and independent claim 12 further recite that the "brackets include a plurality of horizontal tabs" or that the gutter hangers include "horizontal tabs."

The Office Action states that Miles et al. "discloses the gutter hanging brackets as having horizontal tabs (see horizontal tabs adjacent to where 4 and 12 point) which attach to the soffit." (Office Action at 3.) The Office Action also equates the fascia hanger clips 12 of Miles et al. with the recited "brackets" or "gutter hangers." *Id.* However, as shown in Figs. 1 and 3 of Miles et al., the fascia hanger clips 12 do not include a plurality of horizontal tabs. Accordingly, because Miles et al. does not disclose brackets or gutter hangers with a horizontal tabs, it cannot anticipate dependent claims 6 or 12.

Dependent claims 7 and 14 recite that the "soffit is attached to said horizontal tabs." The Office Action again equates the fascia hanger clips 12 of Miles et al. with the recited "brackets" or "gutter hangers," *id.*, to which the horizontal tabs are apart. However, there is no disclosure in Miles et al. of the soffit member 2 being attached to the fascia hanger clips 12 or any other structure. Accordingly, because Miles et al. does not disclose a soffit that is attached to the horizontal tabs, it cannot anticipate dependent claims 7 or 14.

Dependent claim 8 and independent claim 12 further recite gutter hangers, and in the case of claim 8, gutter hangers that "support a gutter along the length of said eaves beam." The Office Action asserts that Miles et al. "discloses the brackets as supporting gutters." *Id.* However, as mentioned, the Office Action equates the fascia hanger clips 12 of Miles et al. with the recited "gutter hangers." *Id.* However, the fascia hanger clips

12 of Miles et al. are not gutter hangers that support a gutter. Rather, in Miles et al., to attach a gutter,

the desired number of braces 50 are attached to the gutter at spaced distances by manually bending hooks 54 around the end of hook 48 and then interfitting hooks 52 with 46 and pressing out tabs 56. The gutter and attached braces are hooked over leg 38 and the selected number of wedge members 60 are pressed between tab 58 and body 14 and legs 72 are manually bent around the ends of the legs of the brace.

(Miles et al., col. 3, ll. 12-20) (emphasis added). In short, the fascia hanger clips 12 of Miles et al. are not properly equated with the recited "gutter hangers." Accordingly, because Miles et al. does not disclose gutter hangers that support a soffit running along the length of an eaves beam, it cannot anticipate claims 8 or 12-16.

Dependent claims 9 and 15 recite that the "soffit protects at least a portion of said rafters and at least a portion of said panels" and dependent claims 10 and 16 recite that the "soffit creates a hollow under at least a portion of said rafters and at least a portion of said panels." As mentioned, Miles et al. does not disclose any panels. Accordingly, because Miles et al. does not disclose a soffit that protects panels, or a portion thereof, or a soffit that creates a hollow under panels, or a portion thereof, it cannot anticipate dependent claims 9-10 or 15-16.

Turning again to independent claim 12, it further recites that the "soffit is supported by said horizontal ledge and said horizontal tabs." Recapitulating, the Office Action equates the mould bar receiver 74 of Miles et al. with the recited "horizontal ledge" and the fascia hanger clips 12 with the recited gutter hangers which have

“horizontal tabs.” (Office Action at 3.) However, as discussed and shown in Figs. 1 and 2 of Miles et al., the mould bar receiver 74 is a separate component from the bracket 98, which the Office Action equates with the recited “mounting arm.” In other words, as discussed, Miles et al. does not disclose a mounting arm having an external trim plate with a horizontal ledge.

Moreover, even if the mould bar receiver 74 of Miles et al. was properly equated with the horizontal ledge of the external trim plate of the mounting arm, it is angular in orientation and is positioned over the soffit member 2. In other words, it rests on the soffit member 2, not vice versa. Accordingly, Miles et al. cannot anticipate claims 12-16. 103

Rejection of Claims Under 35 U.S.C. § 103

It is well settled that “the mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” *In re Fritch*, 23 U.S.P.Q.2d 1780, 1783-84 (Fed. Cir. 1992). “Under section 103, teachings of references can be combined *only* if there is some suggestion or incentive to do so.” *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984).

The Office Action rejected claims 11 and 17 as being unpatentable over Miles et al. in view of Knoebl. Claims 11 and 17 recite that the “soffit is vinyl.”

The Office Action acknowledges that Miles et al. “does not particularly disclose the soffit as being made of vinyl.” (Office Action at 4.) While the Abstract of Knoebl

refers to a vinyl soffit, there is no suggestion in either reference to modify Miles et al. by using a vinyl soffit. The Office Action asserts that it would have been obvious to modify Miles et al. "by using a vinyl soffit in order to prevent corrosion," *id.*, but Miles et al. does not discuss corrosion as being an issue. Nor does Knoebl disclose the use of a vinyl soffit to prevent corrosion. Nor is there any evidence that one of ordinary skill in the art would be concerned about a soffit, that is underneath a roof and as such protected from the elements, corroding.

Moreover, claim 11 depends on claim 1 and claim 17 depends on claim 12. As discussed herein, there are numerous reasons that these base independent claims are not anticipated by Miles et al. In short, the combination of Miles et al. and Knoebl, even if proper, does not disclose all of the limitations of claims 11 and 17. Accordingly, for all these reasons, claims 11 and 17 are not obvious in view of Miles et al. and Knoebl.

New Claims

Applicants have added new independent claim 21 to more particularly claim the disclosed invention. This claim recites that a conservatory roof system is comprised of a generally horizontal and longitudinal eaves beam which is attached to and which supports a plurality of sloped rafters. The rafters support a plurality of sloped conservatory panels which are positioned between the rafters. The rafters and the panels comprise a roof, a portion of which extends exteriorly of the eaves beam, creating an overhang. The overhang having an underside portion.

This claim further recites that there is a mounting arm contiguously attached to, and supported by, the eaves beam, and that the mounting arm has an integral vertical external trim plate with an integral horizontal ledge extending perpendicularly and exteriorly therefrom.

Additionally, this claim recites that there is a plurality of gutter hangers, having integral horizontal tabs, attached to the rafters exteriorly of the eaves beam. Also, a gutter is positioned in and supported by the gutter hangers.

Further, this claim recites that there is a generally horizontal vinyl soffit that parallels and runs along the length of the eaves beam, and rests upon and is supported by the horizontal ledge of the mounting arm and the horizontal tabs of the gutter hangers.

Finally, this new claim recites that a triangularly shaped hollow is formed under the overhang and that the soffit protects the underside portion of the overhang portion of the roof.

This new claim is comprised, inter alia, from elements from original claims 12, 15, 17, and 18. For at least the reasons discussed herein for the allowance of those claims, this new dependent claim should also be allowed. Additionally, because no cited reference discloses a mounting arm contiguously attached to, and supported by, an eaves beam, or a mounting arm having an integral vertical external trim plate with an integral horizontal ledge extending perpendicularly and exteriorly therefrom, this new dependent claim should be allowed.


CONCLUSION

Applicants have made a bona fide effort to respond to each and every requirement set forth in the Office Action. In the event that any issue remains outstanding, the Examiner is invited to contact the undersigned attorney.

Applicants have herewith authorized payment of the requisite fee for the additional independent claims. If any other charges or credits are necessary to complete this communication, the Commissioner is authorized to charge same or credit any overpayment to our Deposit Account No. 23-3000.

Respectfully submitted,

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